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IN THE

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1940.

No. 9.

THE SCHRIBER-SCHROTH COMPANY,

Petitioner,

vs.

THE CLEVELAND TRUST COMPANY,
CHRYSLER CORPORATION,

Respondents.

No. 10.

THE ABERDEEN MOTOR SUPPLY CO.,

Petitioner,

vs.

THE CLEVELAND TRUST COMPANY,
CHRYSLER CORPORATION,

Respondents.

No. 11.

THE F. E. ROWE SALES CO.,

Petitioner,

vs.

THE CLEVELAND TRUST COMPANY,
CHRYSLER CORPORATION,

Respondents.

PETITIONERS' BRIEF.

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PETITIONERS' BRIEF.

THE OPINIONS OF THE COURT BELOW AND OF THIS COURT.

These cases are here for the second time. In its previous decision, 305 U. S. 47, this Court reversed the Circuit Court of Appeals and remanded the causes for further proceedings.

After the decision of the Court of Appeals on the remand, this Court again granted certiorari. 310 U. S. . . .

These three suits were brought against Petitioners (three piston dealers, customers of Sterling Products Company of St. Louis, Missouri) for infringement of five patents.* In all, six different piston structures were accused as infringements (R. 1095-6).

The cases were consolidated and tried before a Special Master, who found all five patents invalid—and if valid, not infringed. The report of the Special Master, at R. 1092-1189, includes Findings of Fact and Conclusions of Law (R. 1096-1109). Respondent's exception to the Special Master's report were overruled, and the Master's Findings of Fact and Conclusions of Law adopted as those of the District Court (R. 1229).

Upon appeal to the Circuit Court of Appeals, the decision of the District Court was in part reversed, holding two patents (Gulick and Maynard) valid and infringed by one of the accused structures, Exhibit 1. 92 F. (2) 330 (R. 2331-2334). The Circuit Court of Appeals dismissed the cases without prejudice as to the other three patents, including the Jardine patent, which is the only one involved in the instant proceeding.

Upon certiorari, this Court reversed and remanded the causes (305 U. S. 47).

Upon remand the Circuit Court of Appeals held (108 F. [2] 109, R. 2396-2406) the Gulick and Maynard patents (as well as the Mooers and Schmiedeknecht patents) to be invalid, but held the Jardine patent to be valid and infringed by Exhibit 1, the same piston which had previously been held to infringe the Gulick and Maynard patents. In effect,

*Mooers, R. 1310; Schmiedeknecht, R. 1306; Gulick, R. 1284; Jardine, R. 1292; Maynard, R. 1300; stated in the order of their filing dates.

Note. The references are to pages of the Record as they appeared in the Court of Appeals. Emphasis in quoted parts is ours.

the Circuit Court of Appeals treated the Jardine patent as covering the same subject matter which was putatively protected by the prior, but now invalid, Gulick patent.

Only the Jardine patent is involved in this proceeding.

For the convenience of this Court, the previous decision of this Court, and both decisions of the Circuit Court of Appeals, are reproduced and filed herewith as a separate pamphlet. The Decisions of the Circuit Court of Appeals will herein be referred to as "First decision" and "Second decision."

JURISDICTION.

These cases are here on Writs of Certorari to the Circuit Court of Appeals for the Sixth Circuit under the provisions of U. S. Code, Title 28, Section 347. The judgments of the Circuit Court of Appeals were entered October 6th, 1939 (R. 2396). The petitions for the Writs were granted by this court on March 25th, 1940. 60 S. Ct. 710, 310 U. S. ....

STATEMENT OF THE CASE.

The Parties.

Respondent,* The Cleveland Trust Company, is a banking corporation holding title (under a trust agreement, R. 1345) to a pool of some eighty patents, R. 2241-2, relating to pistons, particularly of the type employed in internal combustion engines for automibiles. The patents included in the pool were assigned to Respondent by a number of parties, including manufacturers of pistons. The Jardine patent here involved was assigned to Respondent by Aluminum Company of America, R. 1322.

*The Cleveland Trust Company is herein referred to as "Respondent," Chrysler Corporation having been but a nominal and unwilling plaintiff.

Respondent entered into an agreement (Exhibit 38b, R. 1382) in 1924, whereby it granted to Aluminum Company of America an exclusive license under all patents covering aluminum pistons then or thereafter owned by it. In the same instrument Aluminum Company agreed to convey to respondent (subject to such license) all patents relating to pistons per se then or thereafter owned by it, R. 1391; and the Jardine patent was brought under that agreement before it issued by assignment as noted above, R. 1322. There are collateral and sublicenses to Bohn Aluminum & Brass Corporation, R. 1414, and to Aluminum Industries, R. 1408, both piston manufacturers. All of these piston manufacturers own shares of beneficial interest in the pool, R. 271; Aluminum Company and Bohn Company in their own names and Aluminum Industries through its officer and principal Hater. All pay royalties to the pool on aluminum pistons made by them and the proceeds are thereafter paid back to the beneficiaries, R. 274.

Petitioners are located in the Cleveland District and are dealers in pistons made by Sterling Products Company of St. Louis, Missouri, which company has defended these suits.

The Second Decision of the Court of Appeals.

In holding the claims in issue of the Jardine patent valid, the Court of Appeals found Jardine's contribution to reside in a combination, including "**flexing webs,**" as **essential elements** in the patented combination and distinguishing over the prior art; in fact, the Court of Appeals assigned to Jardine the contribution it had previously supposed the Gulick patent to disclose and claim. In holding the Jardine claims in issue valid, the Court **read "flexing webs" into the claims,** Second Dec. p. 6, disregarding the fact that "flexing webs" are not mentioned

in any of the claims of the Jardine patent, but mentioned only in the description.

The Court of Appeals apparently held the Gulick patent ineffective against Jardine, although of an earlier filing date, because of failure of the original Gulick application to describe the webs as laterally flexible, Second Dec. p. 5, although the Court of Appeals in its first decision (p. 10) had considered the Jardine piston as one in which "he cut away all of the skirt portions at the webs, extending the latter to nearly the length of the skirt parts or slippers," R. 2391, although that had already been done by Ricardo, R. 1647 and 1718.

The Long patent 1,877,772, R. 1736, was apparently also held ineffective against Jardine, Second Dec. p. 7, although having an earlier filing date, because it did not describe "flexing webs." The Court of Appeals so held, even though as noted above, the Jardine claims in issue do not mention "flexing webs," and even though Jardine surrendered claims to flexing webs after interferences with Gulick, Long and Hartog in which Jardine lost.

The Long commercial pistons, Exhibits E, F, G, produced in court, and whose dates of use as prior to Jardine were not questioned by the Court of Appeals and which Respondent's own expert conceded had webs laterally flexible, were held ineffective because the Court of Appeals supposed their capability of flexibility was not "then understood," and supposed they were not "known to have that quality" (Second Dec. p. 8).

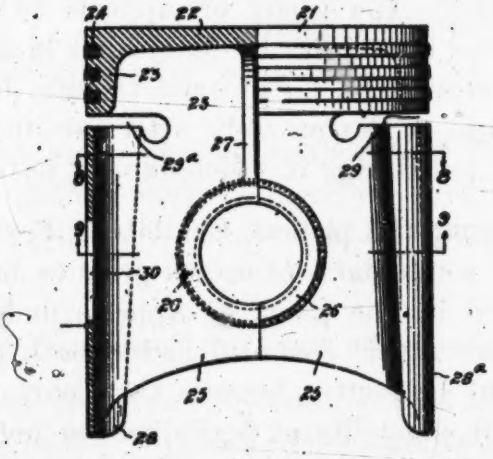
The Hartog patent 1,842,022, R. 1798, which the Court of Appeals found (Second Dec. p. 8) "prior to Jardine" was held not effective against Jardine, even though it describes, as well as claims "internal yielding ribs," because Hartog's thought was "not of the bending or flexing straight ribs," and because "it is a mere paper patent without influence

upon the art"; although the Court of Appeals said in its first decision, p. 11, that "Jardine was without substantial commercial recognition and none of the accused devices are slipper pistons."

The Jardine Patent and Its History.

The Jardine piston (see cut below) comprises a head 21; having a flange 23 provided with grooves 24 for the ordinary piston rings. **Webs** 25 extend from the head and are provided with bosses 26 for a wrist pin. **Slippers** 28 and 28a, also called "guide segments" or "curved guide members," are mounted on these webs. Slots 29 and 29a separate the slippers circumferentially from the head; **these slots extend into the webs for considerable distances and**

Jardine



inwardly beyond the inside of the head flange 23, so as to permit the web extensions beyond the ends of the slots to flex. These slippers are each provided with a longitudinal slot 30.

This piston is stated in the original specification to be a piston "of the so-called **slipper** type," R. 2031,** as dis-

**This expression was later canceled by amendment dated January 24th, 1922, R. 2047.

tinguished from the **full skirt** type. Indeed the Court of Appeals, in its first decision (pp. 10 and 11), refers to the Jardine piston as having "slippers," and that "none of the accused devices are slipper pistons" (p. 11).

Not a single one of the original Jardine claims, R. 2034-7, specified "**flexing webs,**" though conceded by the Court of Appeals in its second decision, page 9, to be the **distinguishing feature** of the Jardine patent over the prior art, and although that feature is not found in any of the claims in the patent as issued.

It was not until April 30, 1923, that Jardine added claims specifying "flexing webs" or synonymous expressions, such as, "yielding ribs," "yielding arms," "skirt carriers susceptible of being slightly flexed radially," "joining means being resiliently yieldable," "means for yieldingly connecting said skirt sections with said head," R. 2067-8. However, these claims were not only copied from pending applications of other parties, but Jardine went into interference with such parties, including Gulick, Long and Hartog, on such claims, as follows:

Interference		Jardine Claims
49570 (R. 2071-3)	Gulick, Long, Hartog	15. 16E (R. 2067)
49572 (R. 2076-8)	Gulick, Long, Hartog	19. 20E (R. 2068)
49578 (R. 2086-8)	Long. Hartog	18. 19E (R. 2067)
49579 (R. 2088-90)	Long, Hartog	17. 18E (R. 2067)
49581 (R. 2090-2)	Long, Hartog	20. 21E (R. 2068)
49583 (R. 2094-6)	Hartog	21. 22E (R. 2068)

Jardine lost each and every one of these interferences as will be seen by the notation "Adverse."* Hence Jardine canceled all of these claims, R. 2208, and thereafter we

*This notation does not appear in Int. 49,583, R. 2095, but the claim appears as claim 4 in the Hartog patent 1,842,022, R. 1801, and it does not appear in the Jardine patent. We also find the claim of interference 49,578 as claim 3 in the Hartog patent.

find no attempt by Jardine to claim "flexing webs," as such or in synonymous terms, and no such claim appears in the Jardine patent.

At no time during the prosecution of the Jardine application was it urged that Jardine was the inventor of a piston having "flexing webs." Even before the interferences, in distinguishing from a Ricardo piston,** the only thing that was stressed was that the splitting of the slippers of the Ricardo piston involved invention, R. 2053, although the thing that was stressed at the trial was that the Ricardo patent did not disclose flexing webs, R. 226.† Even in the amendment canceling the claims in interference, and presenting claims 28 and 31 (now claims 8 and 11 of the Jardine patent held valid by the Court of Appeals), the accompanying argument, R. 2113, stressed other features such as, the integral connection of the webs with the ring flange, and that these webs extend "convergingly inwardly therefrom," which is not even described. There is not even a mention in this final argument of flexing webs, and no attempt was there made to distinguish from Hartog, as the Court of Appeals did in its second decision, page 8, that Jardine's "thought was of * * * the bending or flexing of **straight** (webs) ribs."

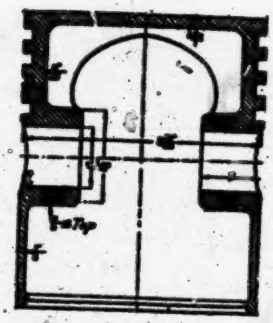
History of Piston Development Before Jardine.

The piston as originally used in automobile engines was what was known as a **Trunk Piston**, a cut of which is shown.

**This piston was the prototype of the Jardine piston and cuts are shown under the next heading.

†The Ricardo commercial piston admittedly had flexing webs (R. 227), as later shown.

Trunk

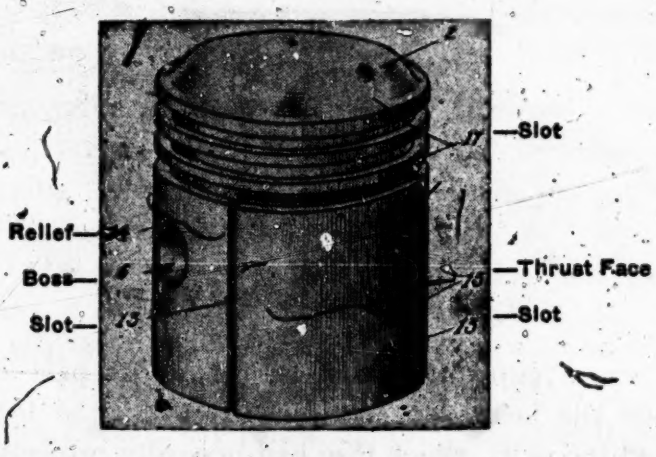


It was a cup-shaped article, the upper part of which formed the head and had ring grooves; the lower part formed the skirt, which also had inwardly projecting wrist pin bosses, while a rib extended from the bosses to the head to strengthen the whole. The head was smaller than the skirt and the latter was smaller in diameter at the hot top than at the cooler bottom. Such a trunk piston, even when made of cast iron, was always hotter than the cylinder; accordingly, various expedients were resorted to to permit the skirt to fit snugly in the cylinder at all temperatures.

The Franquist patent 1,153,902, R. 1688, issued in 1915, and of it the Master said, R. 1119:

> "The specification of this patent is brief, less than two pages, and seems to be the clearest description of conditions encountered, fundamental means to meet those conditions, operation and result, of the many patents and printed publications before the court."

Franquist



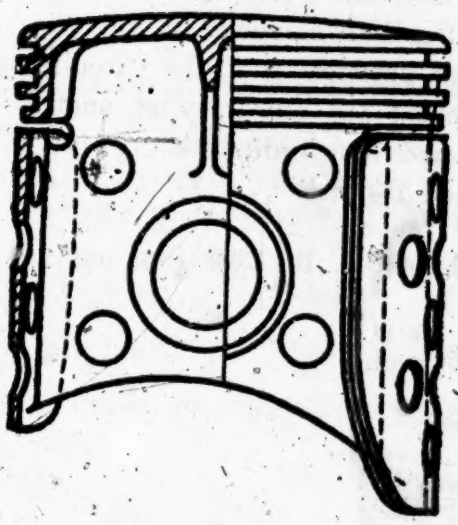
In this piston (see cut) the head was again smaller than the skirt and the head and skirt were separated by a **part-circumferential slot** 17 in the regions of the thrust faces, while the **skirt was relieved**, that is, made of smaller diameter at 14 in the regions of the bosses; furthermore, **vertical slots** 13 permitted expansion to be compensated for. The operation of this piston was about as follows: as the head expanded radially this expansion was not transmitted directly to the thrust faces, because of the part-circumferential slots, but to the skirt in the regions of the bosses, which was, however, permitted because of the reliefs in those regions. The vertical slots permitted further compensation for expansion.*

This patent was acquired by Respondent in 1924, R. 1403, licenses were issued thereunder, R. 1381-1408, 1414, royalties collected, R. 102, R. 2299, suits brought, R. 101, R. 2299, and judgments recovered, R. 1341, even in a suit against Simmons Manufacturing Company, R. 2285, R. 1341 (a customer of Sterling Products Company), because of the sale by that company of a piston identical with Exhibit 1, R. 101. After its expiration, this patent was renounced and denounced by Respondent (R. 247 and 1043).

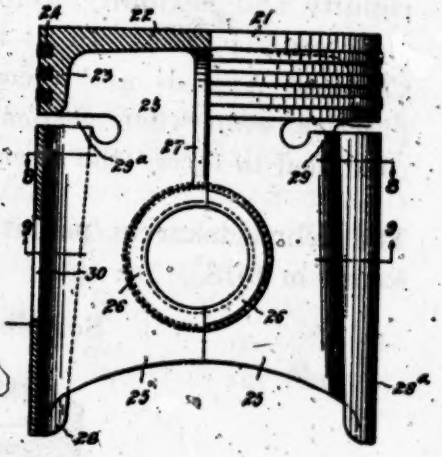
*This Court cited this patent, 305 U. S. 53.

The Ricardo patent 1,294,833, R. 1718, was filed in 1918 and the commercial piston was illustrated that year in the Automobile Engineer, R. 1647 (see cuts).

Ricardo



Jardine



It was what is known as a **"slipper"** piston. **Webs** extended from the head and carried wrist pin bosses, and on these webs were mounted guide sections or **slippers** which were circumferentially separated from the head by slots which went into the webs; in other words, the **skirt parts were cut away in the regions of the bosses** to produce slippers. This piston was used to quite an extent in Europe, R. 218, as an aluminum piston. This piston was really the prototype of the Jardine piston except that the slippers of Jardine were split longitudinally as will be apparent from a comparison of the cuts. Indeed, Respondents' expert admitted, R. 227:

> "I think the construction shown in Fig. 2 of the publication which you have in your hand would show considerable flexibility if the vertical slots were put in the thrust faces.

"Q. Those webs are also thin enough to flex, aren't they, as shown in that publication? A. I think so."

This Court, however, found "Flexibility of the skirt attained by longitudinal slitting was old," 305 U. S., l. c. 53, and that "webs having the inherent property, both of rigidity and flexibility were familiar elements in piston structure," p. 59.** In its first decision, p. 5, the Circuit Court of Appeals also recognized the antiquity of such practice, even when vertical and longitudinal slits were combined to form "the so-called T-slot."

The Schmiedeknecht patent 1,256,265, R. 1306 (see cut), issued in 1918.

Schmiedeknecht

In this piston the bosses were again supported on **webs** and the **skirt was cut away in the regions of the bosses;** however, at the bottom the skirt continued as in Exhibit 1 so as to support the skirt laterally in the regions of the bosses, which overcame the defect of the regular slipper piston in which such piston was not supported laterally and, therefore, resulted in oil pumping; and that was ad-

**That is particularly true as against Jardine filed March 11, 1920, because disclosed in the Pomeroy patent 1,499,073, R. 1804, filed September 4, 1919, and issued to Aluminum Company, and later acquired by Respondent, R. 22., and the Hartog patent 1,842,-022, filed February 16, 1920, and owned by Respondent, R. 1799.

mittedly a defect of the Jardine piston (R. 145). This patent was acquired by Respondent in 1927, R. 1323. It was included in this suit with the contention of infringement by Exhibit 1; the Court of Appeals did not pass upon this infringement but held the patent invalid (2nd Dec., p. 9).

The Long and Gulick Patents.

The Long patent 1,872,772, R. 1736 (see cut infra), bears a filing date of March 7, 1919, and the Gulick patent 1,815,733, R. 1283 (see cut infra), bears a filing date of November 30, 1917; both are, therefore, prior to Jardine (filed March 11, 1920).* Both Long and Gulick were set up in the answer against Jardine, R. 37-8.

Below are reproduced sectional views from the two patents:

Long

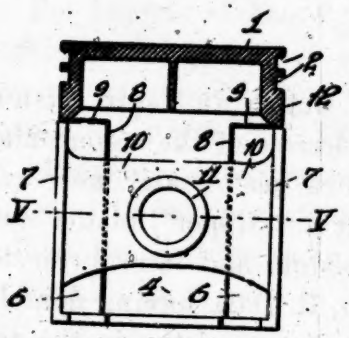


Fig. 3

Gulick

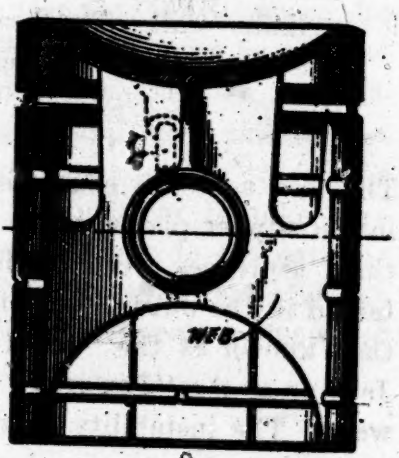


Fig. 1

In each patent the skirt is connected by **webs** to the

*Both constitute statutory bars under R. S. 4486 as to what they disclose. Alexander Milburn Company v. Davis-Bournonville, 270 U. S. 390.

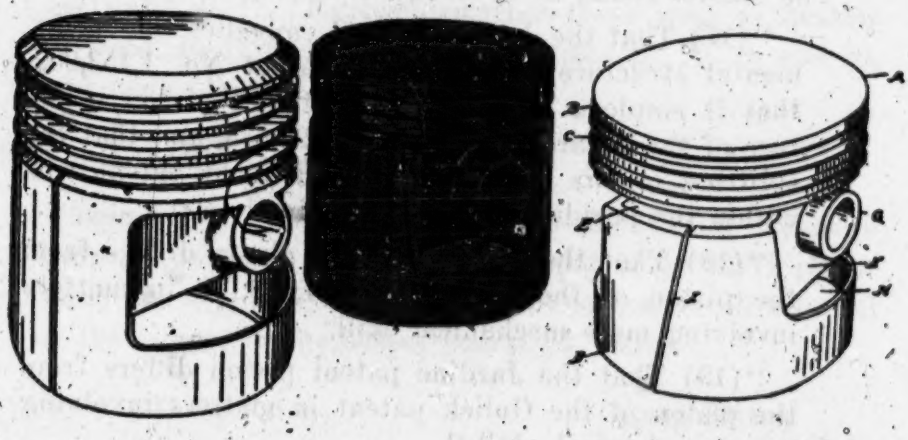
head, and the skirt is **separated** from the head **circumferentially**; in the Gulick patent there is a single **vertical slit** as in Exhibit 1, but in the Long patent there are six **vertical slits**, while in Jardine there are two. In each patent the skirt is a **full skirt** in that it extends circumferentially; however, it will be immediately seen that if the sides of the skirt are cut away in the regions of the bosses, then there will be left in each case a slipper piston just like that of Jardine. Indeed, the Court of Appeals appreciated that in its first decision, p. 10, in showing that the Jardine piston was really an evolution of the Gulick piston by saying:

> "He **cut away** all the skirt portions at the webs, extending the latter to nearly the length of the skirt parts or **slippers**. Horizontal slots partially insulated the slippers from the head and these were split vertically to render them yieldable to contact with the cylinder wall. The head was integrally connected to the skirt only in the region above the bosses."

The first sentence converted the Gulick full skirt piston into a **slipper** piston, while the features of the second and third sentences were in the Gulick piston and were retained in the Jardine piston. But a "slipper" piston was then known as the "Ricardo" piston, and later prior to Jardine as the "**Pomeroy**" piston, R. 1804, having **flexible webs**. The instability of such a slipper piston in the region of the bosses was, however, cured by the Schmiedeknecht piston, by retaining the full skirt at the bottom.

This brings us to the evolution of Exhibit 1, the accused device, which is shown in association with the Schmiedeknecht piston and the Maynard piston; in which Schmiede-

Schmiedeknecht with T Slot | Exhibit 1 | Maynard



knecht piston the T slot of the Long piston has, however, been added.* That evolution even corresponds to Respondent's contention in this case where Exhibit 1 was alleged to infringe the Schmiedeknecht patent.

What has been said with reference the Gulick patent also applies to the Long patent. When the skirt is relieved in the regions of the wrist pin bosses, then we have essentially the piston of Exhibit 1, and such skirts were always so relieved from the very beginning of the piston art, R. 379, 585, 972, by a relief sufficient to take care of expansion in the regions of the bosses to the extreme relief of the slipper piston, and finally with the skirt left full at the bottom as in the Schmiedeknecht patent and in Exhibit 1.

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*The Master said, R. 1163, with reference to the Maynard patent: "All Maynard did was to put the T-slot of Long on the piston of Schmiedeknecht." In his first decision the Court of Appeals stated, R. 2385-6, "combining the vertical and longitudinal splits into the so-called T. slot were old practices," and in the second decision the Maynard patent absent flexing webs was held as not "marking inventive steps over prior art," p. 5.

The Master's Findings Reference Jardine.

The Master found as to the Jardine patent, R. 1099:

"(17) That the Jardine patent embodies the fundamental structure of Franquist patent No. 1,153,902, that it employs essentially the slipper piston structure of the Ricardo patent No. 1,294,833, and that the splitting of the slippers of the Ricardo patent was within the purview of one skilled in the art.

"(18) That the Jardine patent piston differs from the piston of the Long patent 1,872,772 in matters involving mere mechanical skill.

"(19) That the Jardine patent piston differs from the piston of the Gulick patent in matters involving mere mechanical skill."

Absent flexing webs, the Court of Appeals found no more "inventive step over the prior art" in the Jardine patent, than it found in the Gulick patent.

The Hartog and Pomeroy Patents.

We have shown that Hartog was in interference with Jardine and prevailed on claims specifying flexing webs. Hartog was also in interference with Pomeroy on such claims and prevailed, R. 2279; indeed it was the winning of that interference by Hartog which caused the amendment to the Gulick application importing flexing webs, R. 1875.

The Pomeroy piston, R. 1804, is stated to be a "slipper type of piston—Ricardo," R. 1805. The **webs** are formed so as to make them **flex,** R. 1806, line 19, and while the slippers are not split as in Jardine, this patent shows that Jardine was not the first to provide even a slipper piston with flexing webs.

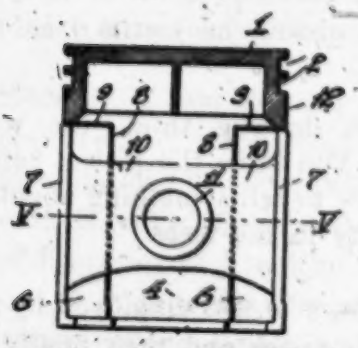
The Hartog piston, R. 1798, was one in which **webs** 12 (called "ribs") extending from the head and carrying

wrist pin bosses 14, also carry arcuate skirt sections 11 **circumferentially separated** from the head at 15 and **split vertically** at 17. Hartog describes these webs as **flexible to yield**, R. 1799, line 64, R. 1800, lines 20, 30, 74 and 94, and even claims this, R. 1801.*

The Long Commercial Pistons.

Below is shown a cut of a Long commercial piston in connection with a cut of the Long patent 1,872,772 previously discussed. The commercial pistons were all relieved in the regions of the bosses (see p. 22, infra).

Long Patent



Long Piston

The Court of Appeals did not question the proof as to the existence and identity of the Long commercial pistons prior to Jardine, and, therefore, evidently found these Long commercial pistons proved as to date and structure. The basis of the Court of Appeals' rejection of the Long commercial pistons as statutory bars against Jardine is

*The Court of Appeals concedes this (2d dec., p. 8). The statement by the court "that it is a mere paper patent without influence upon the art" should be compared with the statement of the Court of Appeals in is first decision (p. 11), "Jardine was without substantial commercial recognition and none of the accused devices are slipper pistons," with the additional fact that the Hartog patent issued to Respondent, who must have thought it so valuable as to purchase it.

that, prior to Jardine, the webs of the Long pistons were not known to have flexing webs, and that those skilled in the art at that time did not understand that they had such flexing webs, the court saying that the webs of the Long pistons were not "known to have that quality" or that this "was then understood" (2nd Dec., p. 8).

Respondents' own expert Jeffries not only testified that he knew that the Long piston was used commercially in the Franklin automobile, not only "like" Exhibits E and F, but that "**those were used**," R. 987. He further testified, R. 940, "I know the Aluminum Company of America made castings for the Franklin Company over a considerable period of time—I think it was some time along 1920, or thereabouts, to about 1926." After again identifying Exhibit F, the first Franklin piston, he testified as follows, R. 1009-1010:

> "Q. What do you say; do you think the webs weren't **flexible enough**? You have the piston before you, so you ought to be able to tell something about it.
> A. No; **there is flexibility in the webs.**"

Petitioners' witness, Stellman, who was employed by the Franklin Company, first as Engineer and then finally as Chief Engineer, after identifying the Franklin pistons, Exhibits E, F and G used in the Franklin automobile from 1919 to 1926, and of Long showing him such a piston in 1916, testifies as follows, R. 570 on cross-examination as to Exhibit F:

> "Q. And it is difficult for you to keep straight just which one was shown you first?
> A. Except that I am very sure that the piston that attracted my attention originally that Mr. Long brought to show us in 1916 had ribs of this type in a general way so that these skirt walls **could flex**. (Referring to Exhibit F.) That is what interested me and made the deep impression on me in 1916."

The above statement of facts, as to the Long pistons, should be sufficient, but in view of the attack upon the Long evidence by respondents' counsel, both in the Court of Appeals and before this court, we will consider the evidence rather in detail.

Further Proof of Long Pistons.

The Master found (Finding 37, R. 1102-3), and as noted by this court, 305 U. S. 55, that the Long pistons "**were in commercial use from 1917 on.**" Respondent's witness Jeffries admitted that the Long piston was the first slit piston in commercial use, R. 986. The Master specifically referred to the physical exhibits, E, F, G and R before the court as having been made and sold by Long, Weems and Franklin Automobile Company.

Exhibits E, F and G were identified by petitioners' witnesses: Venner, who bought and used them, R. 349-350; Chadwick and Royalty, who made them for Long and Weems, R. 378, 338-41; and Stellman, Engineer and later Chief Engineer at Franklin Company, who made the first use of them in a Franklin car in March, 1919, and made a written report, R. 452 and 1629, and later put them in Franklin automobiles, first for replacements beginning April, 1920, and then in regular automobile production beginning November, 1920, R. 456-7.

At the trial the Long piston was put forward by Petitioners as developed as early as March, 1916, and the Master so found, R. 1102, 1174.* As this was prior to Gulick's filing date, Respondent called a number of men, who had been at Franklin Company, to show negatively what had not been done there commercially, although there was no contention on the part of petitioners that there was even a

*The Court of Customs and Patent Appeals so found in the interference, Hartog v. Long, 47 F. (2d) 369, quoted from by the Master, R. 1174.

test Long web type pistor at the Franklin Company before 1919.

These witnesses called by Respondent, however, fully corroborated Petitioners' witnesses as to what Long pistons were in existence, and even used and sold, prior to Jardine's filing date of March 11, 1920. All identified Exhibit F as having been used in a Franklin car—in a thorough test run in **March, 1919**: Murphy, R. 654, 661, and who initialed, R. 661, Stellman's report, Exhibit Z, R. 1629, of that run; Castor, R. 665-8, and Burns, R. 679, 687, 690, who even identified that piston as being the piston of the Long patent 1,872,772, which has a filing date of March 7th, 1919.

The existence and identity of the Long piston, Exhibit F, was established as having been before March 11th, 1920, Jardine's earliest date, not only by Petitioners', but by Respondents' witnesses. Exhibits E, G and R were also established as to identity and date before Jardine's filing date, these pistons distinguishing from Exhibit F by the fact that Exhibit F was cast in a sand mold, while Exhibits E, G and R were cast in a metal mold and had more ribs in the head.

To still further establish the identity, as well as the date of the Long piston, Exhibit F, Petitioners also introduced a pattern, Exhibit GG1, and a core box, Exhibit P.. We will here pause to explain the making of a casting by sand molding. A pattern having the shape of the outside wall of the casting and having a "core print" of the shape of a part of the "core" is employed to produce a cavity in sand. A divided "core box" shaped to the inside walls of the casting and of a part to fit the cavity made by the "core print," is packed with sand and a binder to produce the complete core which is then baked. The core is then put into the mold and the metal is poured into the resulting matrix to form the casting, the casting being removed from the friable sand. By a given set of pattern and core box,

castings can be produced which are duplicates in every respect, and that was done with the pattern and core box for making the Long piston.

The pattern, Exhibit P, was obtained from Gilbert's foundry where it has been since March, 1919, and was fully identified as coming from that source, R. 413-425 and 1640. The core box, Exhibit GG1, was produced by Chadwick, R. 376, from his shop (purchased from Weems, who previously had purchased the shop from Long), and identified as having a date as early as 1918, R. 376, and as having been used by Gilbert's foundry and Walker Leavitt for the making of castings, R. 375-7. This core box was also identified by Gilbert, R. 423, who used it before April, 1917, R. 428. Gilbert took the pattern and the core box, made a mold with the pattern, made a core with core box, put them together and made a casting, Exhibit NN, which is identical with Exhibit F, except that the latter has been machined. That "it would be a miracle" if a mold made by a pattern and a core from a core box would fit together, unless they belonged together, was verified by Gilbert, R. 427.

It will be noted that the pattern was taken away from and returned to Gilbert's foundry on a number of dates, including **February, 1919**, R. 1640-41. Chadwick testifies that Long took pistons like Exhibit F with him to the Franklin Company at Syracuse in **March, 1919**, R. 396, and these pistons were used in the Franklin car on **March 18th, 1919**, Exhibit Z, R. 1629-31. Two days after Stellman's report, namely, **March 20th, 1919**, Franklin Company took a license (R. 1632), under the then pending application for the Long patent 1,872,772, filed March 7, 1919. The pattern and core box were returned by Gilbert on **March 21, 1919**, R. 1642, and Respondents' witness Murphy testified that on **May 3rd, 1919**, there was an order to Walker M. Leavitt for two hundred fifty of these pistons, R. 657. Note here the marking of "Leavitt," not only on the core exhibit

GG-1, as well as on Exhibit F, and that Chadwick also testified that this core box was shipped to Leavitt, R. 377.

The evidence with reference to the mold, the core box, the casting produced by the two, and the piston, Exhibit F, tie them together and with the first use of Exhibit F at Franklin in March, 1919, and there can be no doubt that the date of Exhibit F, as well as its identity, has been established as about one year prior to the date that Jardine filed. Furthermore, all of the witnesses, Petitioners' as well as Respondent's, have identified this Exhibit F.

Although Franklin took a license after March, 1919, use, which was highly satisfactory, Franklin did not proceed to put the Long pistons in **regular** replacement "service" until April, 1920, nor into **regular** automobile "production" as standard equipment until November, 1920. The reason for the delayed adoption of the Long piston as regular equipment by Franklin Company was given by Stellman, R. 456-458. However, as stated by Respondent's witness, Burns, R. 691, even before the service announcement of April 15, 1920, and even in the fall or winter of 1919, the Franklin Company started to machine the Long pistons and put them into cars, and even the "service department took some of them," and they were even offered to and used by Long dealers. During 1919 Weems was making and selling this Long piston, as is verified by Chadwick, who quotes from an inventory of Long pistons on hand, R. 386, and from a record of the royalties paid Long by Weems, both as early as December, 1919, and from a shipment to Franklin dealers the first part of 1920, R. 388. Venner used them as early as 1917, R. 349.

That these Long pistons, Exhibit F, had the reliefs in the regions of the bosses was verified by Stellman, R. 459-492; Venner, R. 345; Chadwick, R. 387; Royalty, R. 436. Respondents' witness Burns even says, R. 685:

"As to reliefs on pistons you had to have some place

to expand it, for it to go into, and there was a hugging action going on, if you didn't grind it elliptical, you had to put a relief in there."

Of course, a relief was so common in pistons that Long's patent counsel did not bother to even mention it in the patents (R. 489). Accordingly, we find no specific statement of a relief in the Long patent 1,872,772. The Franquist patent (R. 1688) had described it as early as 1915. Chadwick says, "it has been done ever since I knew anything about gasoline engines," R. 379. Stellman said those reliefs were in general use in 1915, R. 585. Jeffries admitted that reliefs were used as early as 1917, R. 972.

As to the clearance of the Long pistons as used in Franklin automobiles, this was originally .002 of an inch as admitted by Respondent's witnesses, Castor, R. 666, and Burns, R. 679. Stellman stated that when these went into actual service in April, 1920, the clearance was from .002 to .003 of an inch, R. 455, 1587. This was equal to the clearance of a cast-iron piston in a Franklin car, R. 460, while aluminum pistons used before Long's required a clearance of .008-.0011 of an inch, R. 546. The Franklin engine was an air-cooled engine, and, therefore, got very hot, so that there was the worst possible condition (Stellman, R. 458; Jeffries, R. 987). There is no evidence what the clearance of Exhibit 1 would be in a Franklin car, because it was never used there; in fact, Stellman testifies that he could not use it at all, R. 528.

Respondents' witness Castor testified, R. 672, that the Long piston was used exclusively in the Franklin car from 1920-1929 to a total of 64,000 cars, totaling over 350,000 pistons. In 1929, because of the high increase in compression of the Franklin automobile, which, of course, meant higher temperatures, the Long piston would not stand up any more. The change was not, however, to an all alumi-

num piston like Exhibit 1, but to a piston known as the "invar strut," which is exemplified by Exhibit AAA, and has steel inserts. While Castor testified that at the time of the change the clearance necessary for Long was .005" and from .0025-.003" for the invar strut, the difference here, of course, is between a piston having parts of low expansion steel and a piston made entirely of aluminum.

As against this unquestionable commercial success of the Long piston, for it was admittedly the first split piston in commercial use, R. 986, Respondent offered no evidence of commercial success of the Jardine piston at all. No piston of the Jardine patent, nor even of the Maynard patent, was offered to the Franklin Company, R. 1011. As the Court of Appeals says in its first decision (p. 11): "Jardine was without substantial commercial recognition." Respondent's witness Jeffries admitted that the Jardine piston was subject to oil pumping, R. 145, while the Long piston had an excellent oil consumption record, R. 1629-30. There is no evidence as to the clearance required for the operation of the Jardine piston, but we do know that the Maynard piston, said to be based upon the Jardine piston, could not be used in a Franklin air-cooled engine at all and was rejected by Stellman, R. 548.

The first commercial split skirt piston put on the market by any of Respondents' licensees did not appear until 1923, R. 69. This was five years after the Long pistons had been on the market and three years after it was put into commercial production by the Franklin Company. After 1924, with the acquisition of the broad Franquist patent by Respondent, R. 1403, with the certainty that Long would lose the Gulick interference, and with one of the licensees, Aluminum Company of America, the owner of broad patents covering processes and modes for producing chill cast aluminum alloy pistons and even cover-

ing the pistons per se*, the coterie of licensees were in a position to drive the Long piston off of the market, particularly since the Long pistons had to be chill cast as were those put into production by Franklin Company in 1920, Exhibits E and G. Long was actually sued by Respondent for infringement, R. 2261, and the Bill was not dismissed until he agreed to buy castings from Respondents' licensees, R. 290; in other words, thereafter Long was in competition with manufacturers from whom he had to purchase his castings.

The Accused Piston, Exhibit 1.

The Court of Appeals said in its first decision, p. 11:

> "Jardine was without substantial commercial recognition and none of the accused devices are slipper pistons, since whatever Jardine contributed to the art, if anything, is said to be incorporated in Maynard and since the really important infringement is said to be the copying by the defendants of the commercial embodiment of Maynard, we feel under no necessity at this time of ruling upon the validity of the Jardine patent or the fact of its infringement."

The Master said as to Maynard (R. 1163):

> "All Maynard did was to put the T-slot of Long on the piston of Schmiedeknecht."

The Court of Appeals evidently came to that conclusion in its second decision (p. 5) in holding the Maynard patent invalid as not "marking inventive steps over prior art."

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*See Aluminum Company of America v. Sterling Company, 66 F. (2d) 958, C. C. A. 8, which enumerates and discusses the scope of the patents. The Master referred to this case, R. 1141. Likewise did Respondent's witness Jeffries, R. 90-91, who also described the procedure, R. 104-5, and indeed states that the advent of the aluminum piston began with that procedure, R. 95, 100. and indeed is what made it successful, R. 144.

The Master's statement (R. 1116) that Exhibit 1 is

> **"a stiff piston,** being a truss construction with a chord spanning an arc, and when this piston scored, resort was had to what is now known as the 'Keystone relief.'"

is equally applicable to the piston (see cuts below) of the Maynard patent, which the Court of Appeals said "made no impression upon the Court as marking inventive steps over the prior art," second decision, page 5.

Exhibit 1

Maynard

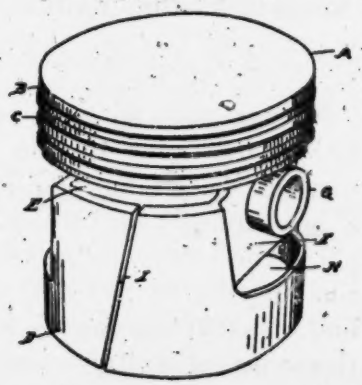

Exhibit 1 comprises a head, a skirt, webs spanning the skirt and carrying wrist-pin bosses, circumferential slots separating the skirt from the head in the regions of the thrust faces, with one of these thrust faces split vertically. However, **the circumferential slots do not go into the webs beyond the inside of the head flange**; accordingly, there cannot be any flexing webs at the top, where such flexure is necessary if compensation for expansion is accomplished by flexure, as distinguished from at the bottom, where web flexure is not necessary, as admitted by Respondents' expert witness, Jeffries, R. 1038. Stellmann showed that there is no web flexing at the top in Exhibit 1 (R. 525-7 and Ex. 4-A, R. 1649) and that, accordingly, there was rubbing at the corners, requiring cut-

ting away of the thrust faces at the corners to produce the "Keystone relief." The Master discussed this (R. 1127).

The history of Exhibit 1 by Respondent's witness shows the following: It was attempted to place upon the market a piston like Exhibit 1, but without the Keystone relief, and Exhibit 21 (R. 1337) was proffered by Respondents' witness Jeffries as a structure showing a Jardine, as well as a Maynard, piston. Jeffries admitted on cross-examination, R. 1045, that his previous statement, R. 178, of extensive use was based upon hearsay, for he admitted that he had never installed nor even seen such a piston, but had seen a drawing; he did not even know whether such a piston ran for 100 miles, R. 1046. On cross-examination, Jeffries produced unfinished castings (Exhibits 3-M and 3-N), which admittedly did not have that Keystone relief, R. 135. On redirect examination, R. 189, Jeffries then produced drawings (Exhibits 21 and 22, R. 1337-40). Of these only Exhibit 22 shows the Keystone relief, but it also bears the notation, "their wire" (evidently Oakland Motor Car Company's), and the **Keystone relief was "added" February 10, 1925**, namely, five years after the filing of the Jardine application. There is no evidence of any piston like Exhibit 1 having gone into use without that Keystone relief.

SPECIFICATION OF ERRORS ASSIGNED AND TO BE URGED.

1. That the Court of Appeals for the Sixth Circuit erred in finding and holding patentable a combination including an essential element not mentioned in the claims of the Jardine patent in suit, and which was in fact surrendered during the prosecution of the application, and in refusing to follow this Court's decision in this cause, 305 U. S. 47, and this Court's decision in Permutit Co. v. Graver Corp., 284 U. S. 52.

2. That the Court of Appeals erred in refusing to hold the Jardine patent in suit invalid, when the feature found to be an essential element of the patented combination was actually present in the same combination in devices proven to have been in prior use and on sale before the earliest proved date of the alleged invention of the patent in suit, and in refusing to follow this Court's decision in De Forest Radio Co. v. General Electric Co., 283 U. S. 664, 51 S. Ct. 563.

3. That the Court of Appeals erred in granting an injunction against infringement of the Jardine patent in suit by the sale of aluminum pistons by Petitioners where the Respondent, a banking institution, was simply an Assignee in Trust under a pooling agreement of some eighty patents, including the Jardine patent in suit, and where Respondent had granted a license to Aluminum Company of America, a corporation, giving it the exclusive right to make, use and sell aluminum pistons under the pooled patents, including the Jardine patent in suit, and where Respondent was never entitled to make, use or sell aluminum pistons in accordance with the Jardine patent in suit.

4. That the Court of Appeals erred in reversing and in not affirming the judgment of the District Court holding the Jardine patent in suit invalid, and even if valid, not infringed, and in awarding any costs to Plaintiff-Respondent.

SUMMARY OF ARGUMENT.

A summary of Petitioners' Argument appears in the captions of the three points, which are set forth in the "Argument." It is not thought feasible to expand the summary beyond these captions without unduly lengthening this brief and resorting to very considerable repetition.

ARGUMENT.

We assume that this court will not consider any questions other than those upon which the Petition for Certiorari is based. However, it was Petitioners' contention before the courts below, and Petitioners are still insisting, that the piston, Exhibit 1, does not infringe the Jardine patent, even if the latter is valid. That is particularly so in the light of the admission of Respondent's witness Jeffries, R. 230-1, that the extension of the circumferential slot inwardly to the extent appearing in Exhibit 1 is not sufficient to make the webs of that piston "flexing webs," and upon which the Master based his Finding 48, R. 1105, of non-infringement of the Jardine patent. Petitioners, moreover, still insist that the Jardine patent is invalid over the prior art as concluded by the Master and the District Court, particularly if "flexing webs" be excluded from the claims, and since the Court of Appeals found that to be the only thing which distinguished the Jardine claims from the prior art.

POINT I.

The Circuit Court of Appeals Treated "Flexing Webs" as Essential Elements of the Jardine Patent, and Held the Patent Valid Notwithstanding That Such Elements Are Not Mentioned in Any of the Claims, But Were in Fact Surrendered During the Prosecution of the Application After Adverse Decisions in Interferences, and Intentionally Excluded From the Patent as Essential Elements, and the Court of Appeals Refused to Follow the Decisions of This Court.

Summarizing the prosecution of the Jardine application in the Patent Office, as shown in the Statement, we find the following: the original application described flexing

webs, but did not claim such webs; thereafter claims, including flexing webs, were added by amendment; thereafter interferences were declared involving claims specifying flexing webs; thereafter decisions were rendered in those interferences adversely to Jardine on such claims; thereafter Jardine canceled all claims specifying flexing webs and stressed other features; finally, the Jardine patent issued with claims, none of which mentions flexing webs. It clearly was not intended, when the patent was granted, that the thing patented depended upon "flexing webs," but rather that the webs might be of any character.

The Court of Appeals found no validity in any of the Jardine claims, absent flexing webs, because, as to the Gulick piston, which the first decision of the Court of Appeals (p. 10) deemed Jardine's prototype, and as to the Maynard piston, which that first decision (p. 11) deemed Jardine's specific form, the second decision found the Gulick patent invalid "as marking no inventive step over prior art," and the Maynard patent invalid as not "marking inventive steps over prior art." The Court of Appeals, therefore, found it necessary to read into the Jardine claims "flexing webs" (second decision, pp. 6, 9), and even (p. 8) "bending or flexing of **straight** ribs * * * on the **cantilever** principle." That, we submit, is contrary to the Patent Statute, R. S. 4888, and the decisions of this Court construing that statute.

The Patent Statute, R. S. 4888 (35 U. S. Code 33), requires an applicant for a patent to not only file a written description of his invention, but to

> "particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery."

In White v. Dunbar, 119 U. S. 47, l. c. 51-52, this Court stated the purpose of the Patent Statute and the limits of the interpretation of claims as follows:

> "Some persons seem to suppose that a claim in a patent is like a nose of wax which may be turned and twisted in any direction, by merely referring to the specification, so as to make it include something more than, or something different from, what its words express. The context may, undoubtedly, be resorted to, and often is resorted to, for the purpose of better understanding the meaning of the claim; but not for the purpose of changing it, and making it different from what it is. The claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is; and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms."

In McCarty v. R. R. Co., 160 U. S. 110, l. c. 116, it was sought to read a feature into the claim of a patent to save it. This court says:

> "There is no suggestion in either of these claims that the ends of the bolster rest upon springs in the side trusses, although they are so described in the specification and exhibited in the drawings. It is suggested, however, that this feature may be read into the claims for the purpose of sustaining the patent. While this may be done with a view of showing the connection in which a device is used, and proving that it is an operative device, we know of no principle of law which would authorize us to read into a claim an element which is not present, for the purpose of making out a case of novelty or infringement. The difficulty is that if we once begin to include elements not mentioned in the claim in order to limit such claim and avoid a defense of anticipation, we should never know where to stop."

That case was cited with approval by this Court in **Permutit Co. v. Graver Corp.**, 284 U. S. 52, which involved a situation as here, where the Court of Appeals had read into the **claims** of the patent what that court found was an essential element, namely, a "**free**" zeolite bed, while the claims mentioned only a "bed * * * of zeolites." While in that case the specification also failed to describe the bed as a "free" bed, this Court considered both phases (description and claims) of the Patent Statute, R. S. 4888. After stating that the **claims did not** "make mention of a 'free' zeolite bed" and that the patentee had "failed particularly to point out and distinctly claim the free zeolite bed," and that "the patent is void," this Court says (l. c. 59):

> "The absence in the **claims** of a sand bed placed above the zeolites does not imply that the zeolite bed is to be unconfined. The only normal inference from such silence is either that it was deemed immaterial whether the zeolite bed be locked or free, or that if a free bed is preferable, it was not claimed because it lacked novelty."

This Court then states the purpose of the Patent Statute as follows (l. c. 60):

> "The statute requires the patentee not only to explain the principle of his apparatus and to describe it in such terms that any person skilled in the art to which it appertains may construct and use it after the expiration of the patent, but also to inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not. The free bed was neither described in the specification nor **claimed** in either Claim 1 or Claim 5."

In the decision of this Court in this case, 305 U. S. 47, the

situation was as in Permutit v. Graver with reference to the **Maynard** patent, in that neither the specification nor the **claims** mentioned "flexible webs" found by the Court of Appeals to be essential elements. This Court, after considering Permutit v. Graver, and quoting the part just quoted therefrom relating to the claim requirement, says (p. 10):

> "We conclude that the court below erred in giving any effect to so much of the Gulick patent as by amendment describes or **claims** the flexible webs, and in treating any of the specifications or **claims** in Gulick and Maynard as referring to such webs."

The above necessarily follows from R. S. 4888, which requires not only a "written description of the same," i. e., of the thing to be patented, but also that the patentee "shall particularly point out and distinctly **claim**" the thing to be patented.

White the specification may be resorted to "for better understanding the meaning of the claim" (White v. Dunbar, supra), and "with a view of showing the connection with which the device is used" (McCarty v. R. R. Co., supra), the question is not simply whether a characteristic* of an element can be read into it; the question is much more narrow, namely, whether

> a feature, found by the Court of Appeals to be an essential element of the patent, in order to hold it valid over the prior art, can be read into the claim by reference to the specification, where that feature was once included in the claims presented by the appli-

*In Permutit v. Graver the limitation "free" really defined the characteristic of the element "bed"; indeed, "free" and "flexible" are related. In Altoona Theatres v. Tri-Ergon, 294 U. S. 477, 489 (later discussed), a broad element "means" was restricted by disclaimer to a specific one, "a flywheel," which was held to constitute a "new element." Of course, an element defined by a characteristic is a different element than one not so defined.

cant, but excluded from claims as finally issued, after adverse decisions in interferences on claims including such a feature.

In this case the Court of Appeals has not only departed from the decisions of this Court, but from a previous decision of the same court, namely, **Wm. B. Schaife & Sons v. Falls City Woolen Mills Co.**, 209 F. 210, where Judge Denison, after stating the **general rule**, that ordinarily a claim should be construed in connection with the specification, states the **exception** as follows (l. c. 213):

> "but where, from the specification or the **history** of the application or the language of the claim it is clear that the patentee intended to claim and the Patent Office intended to grant the broader monopoly which turns out to be invalid, the courts will not, for the arbitrary purpose of saving the claim, read into it a limitation which it does not have."**

The Omission of Flexing Webs from Jardine's Claims Was Deliberate and Intentional.

The history of the Jardine application, as well as the language of the claims of the patent, makes it clear that Jardine intended to claim and the Patent Office intended to grant the broader patent monopoly which now turns out to be invalid. The Jardine original application described flexing webs; thereafter claims including flexing webs were added by amendment; but in interference proceedings, decisions were rendered adversely to Jardine, followed by cancellation of such claims and the retention and submission of claims, none of which mentioned flexing webs. Under such circumstances it cannot now be said that the intention was to include flexing webs in the

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**Judge Denison cites McCarty v. Lehigh Valley R. R., 160 U. S. 110, 116, and Stearns v. Russell, 85 F. 218, 224, C. C. A. 6, in which the decision was by the later Chief Justice Taft, with whom sat the later Mr. Justice Lurton.

claims. Here paraphrasing this Court's statement in Permutit Co. v. Graver Corp. (l. c. 59, 284 U. S.):

> The only normal inference from such silence is either that it was deemed immaterial whether the webs were rigid or flexing, or that if flexing webs were preferable, they were not claimed because they lacked novelty.

Such inference can be drawn here. Jardine knew that as to him, **flexing webs lacked novelty,** because already disclosed by Hartog and Pomeroy, to say nothing of Long. Jardine also knew when he canceled claims specifying flexing webs on May 7, 1930, R. 2108, that it was really **immaterial whether the webs were rigid or flexible,** because at that time the accused piston (Exhibit 1) was on the market, R. 21. The Master found, R. 1116, that Exhibit 1 was "**a stiff piston,** being a truss construction with a chord spanning an arc," and one in which, R. 1105,

> "automatic compensation is accomplished by what has been termed 'Keystone relief' and not by any web flexibility at the top; that **the circumferential slotting terminates about the inside of the head flange.**"*

We submit that the omission of the claims from the Jardine patent of flexing webs was deliberate and intentional.

The Court of Appeals Found the Distinguishing Feature to Reside in Flexing Webs.

That the Court of Appeals found the thing which distinguished the Jardine patent from the prior art to reside

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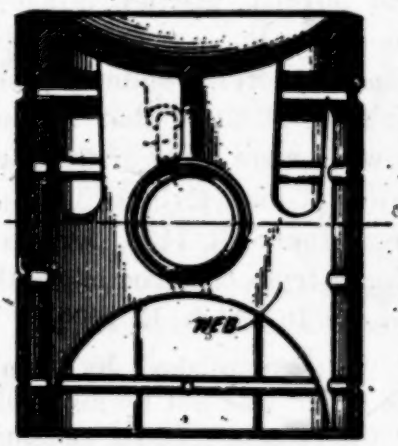
*This finding was based not only on what the Master saw and heard, but was particularly based upon the admission of Respondent's expert Jeffries (R. 231), that with such a construction

> "It would be quite difficult to secure successful operation under such conditions."

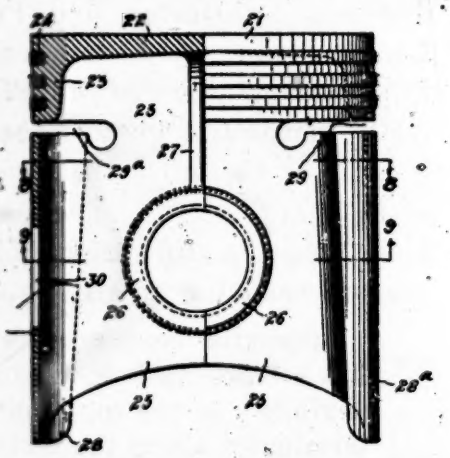
By that Jeffries meant successful operation in accordance with a view that the webs should be flexing rather than rigid.

in "flexing webs" is clear not only from that court's second decision, but also from its first decision; indeed, the prior art as to Jardine was such that there could be no patentable novelty in Jardine's piston, absent flexing webs. We have discussed this prior art in the Statement, so that a mere resumé of the Gulick and Ricardo pistons should be sufficient here:

Gulick



Jardine



The Court of Appeals in its first decision (p. 10) considered Jardine's piston with respect to the Gulick piston as follows:

> "He cut away all of the skirt portions at the webs, extending the latter to nearly the length of the skirt parts or slippers."

That surely was not an inventive act when that is exactly what Ricardo had done to produce, like Jardine, a slipper piston. Indeed, the Gulick piston was, if anything, an improvement over Jardine's piston because the leaving in of the side walls secured lateral stability and therefore prevented oil pumping, which was admittedly a defect of the Jardine piston, R. 145. The fact is that the side walls

were retained in the Maynard piston and Exhibit 1 for that very purpose, R. 81-2.

Surely a step backwards in the art from Gulick to Jardine cannot be considered an inventive act; the Court of Appeals did not so consider it, and therefore found it necessary to read flexing webs into Jardine's claims to sustain them over Gulick, who did not disclose such flexing webs.

Although the Court of Appeals in its first decision had said (p. 11) that "Jardine was without substantial commercial recognition and none of the accused devices are slipper pistons," it proceeded in its second decision (p. 5) upon the basis that

> "Jardine with great clarity and in precise detail explains the principle of operation of his machine and the **flexibility** of its **webs.** The knowledge that was not Gulick's or was by him concealed, is clear to Jardine and by him proclaimed."

The Court of Appeals, after considering the Jardine description, including "**bending** of the **webs,**" and then considering the claims, said (p. 6):

> "While the specimen claims of Jardine, 1, 8 and 11, though reciting the **web** as an element do not incorporate therein the property of **flexibility**, yet in the light of the description they must be so interpreted."

The Court of Appeals then found those claims valid, and stated (p. 9):

> "Our conclusion in this respect is **based upon** the **concept** of a combination with balanced skirt flexibility due to cooperation of longitudinal and vertical slotting with **flexing webs** supporting retracted bosses and connected to a skirt thereby made responsive to physical compression and thermal expansion so as to

> permit of minute clearances between piston and cylinder, a concept perceived in Gulick as amended and minus amendment no longer perceived."

What the Court of Appeals actually did was to practically substitute the Jardine patent for the Gulick patent, after this court had decided that flexing webs could not be read into either the specification or the **claims** of the Gulick application as filed, or of the Maynard patent as issued, and that the Court of Appeals erred

> "in treating any of the specifications or **claims** in the Gulick and Maynard patents as referring to such webs," 305 U. S. 60.

In so treating the Jardine claims as referring to such webs, the Court of Appeals, therefore, not only misinterpreted this court's decision in the cases cited supra, but even the decision in this case, and departed completely from its own previous decision as to the effect of the **history** of a patent application while pending in the Patent Office—here the cancellation of claims specifying flexing webs after adverse decisions in interferences.

The Court of Appeals Read Particular Flexing Webs Into Jardine's Claims, Contrary to This Court's Decisions.

We have seen that in **Permutit v. Graver,** supra, and again in this case, this court stated the object of R. S. 4888 as follows, 305 U. S. 57:

> "The object of the statute is to require the patentee * * * 'to inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not.' "

And in **White v. Dunbar,** supra, l. c. 52, that

> "it is unjust to the public, as well as in evasion of

> the law, to construe it (a claim) in a manner different from the plain import of its terms."

The uncertainty of the Court of Appeals as to what is to be included in or excluded from the claims of the Jardine patent appears from the second decision. The Court of Appeals first considered the prior art **generally**; more particularly that which had been found effective against the Gulick and Maynard patents, and apparently found in them no disclosure of flexing webs. The Court of Appeals then proceeded to import "flexing webs" into the claims by construction "in the light of the description." The Court of Appeals next considered the Long patent and the Long commercial pistons, but apparently found no disclosure of flexing webs in the patent description; and although such flexing webs were in the Long commercial pistons, these were held unavailing as statutory bars, because the webs of these Long pistons were not "known to have that (flexing) quality," or that this "was then understood." The Court of Appeals then considered the Hartog patent which the Court found "prior to Jardine, **claims** internal **yielding** ribs" (webs).* The Court then apparently found that the characteristic feature of "flexing webs" was not sufficient to distinguish Jardine from Hartog and, therefore, found it necessary to still further read into the Jardine claims

> "the bending or flexing of **straight** ribs **so proportioned** as to yield to the thermal expansion of the bosses on the **cantilever principle**" (R. 2404).

Surely such a progressive "turning and twisting" of a

*In the Hartog patent, R. 1798, Hartog calls webs 12 "ribs 12, to have a *yielding* effect when in operation both in *lateral* and circular direction," R. 1800, l. c. 29. Claim 5 of Hartog, R. 1801, however, describes "a *flexible* interior rib member," while claim 3 specifies "skirt carriers—susceptible of being slightly *flexed* radially." This latter was the claim in the Hartog interference in which the decision was adverse to Jardine, R. 2086-7.

claim "so as to make it include something more, or something different from, what its words express * * * is unjust to the public, as well as an evasion of the law." (White v. Dunbar, 119 U. S. 51-52.) As this court says in McCarty v. R. R. Co., supra,

> "The difficulty is that once we begin to include elements not mentioned in the claim in order to limit such claim, and avoid a defence of anticipation, we should never know where to stop." (160 U. S. 116).*

It was just such a situation that the Patent Statute was intended to remedy, in order to inform the public "of the limits of the monopoly asserted." An element certainly cannot be imported by construction and not even by disclaimer restricting an element to one having a specific construction or specific characteristics.** Surely if an element may not be imported into a claim by disclaimer, it cannot be imported by judicial construction. That is particularly so where, as here, Jardine lost claims, including flexing webs in interference proceeding; and whether the Patent Office was right or wrong the court

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*This Court in General Electric Co, v. Wabash Appliance Co., 304 U. S. 364, says 369:

> "The statute seeks to guard against unreasonable advantages to the patentee and disadvantages to others arising from uncertainty as to their rights."

**Altoona Theatres v. Tri-Ergon Corporation, 294 U. S. 477, 489, involved a situation where the claim of a combination patent described an element in broad terms, namely, "means for imparting to the film a rapid and uniform motion", by disclaimer that element was restricted to a specific means, namely, "a flywheel." That this court held was unauthorized by the disclaimer statute, because involving "the addition of a new element to the combination previously claimed, whereby the patent originally for one combination is transformed into a new and different one for the new combination." This court further said, "if a change such as the present could validly be made, it could only be under the provisions of the Reissue Statute, R. S. 4916," l. c. 490.

need not inquire, because the cancellation of the claims amounted to disclaimers.†

As previously stated, the case here is not even as broad as involving simply the importation into a claim of a specific element, or even the characteristic of a specific element described in the specification, but is coupled by the additional limitation that "flexing webs," the very thing sought to be imported into the claims to save them, were surrendered by Jardine by cancellation of claims specifying such flexing webs, after Jardine had lost the interferences on such claims. Of course, no claim was ever made by Jardine that he was the inventor of a piston characterized by

> "the bending or flexing of **straight** ribs (webs) **so proportioned** as to yield to the thermal expansion of the bosses on the **cantilever principle**" (R. 2404)

which the Court of Appeals finally imported into the Jardine claims, after consideration of the Hartog patent with its "yielding ribs" (webs) or as stated in Hartog's claim 5 "flexible interior rib members."

The Court of Appeals Found Infringement by a Piston Which Has No Flexing Cantilever Webs.

The Court of Appeals found Exhibit 1 to be an infringement of this Jardine patent, although the webs of Exhibit 1 have no web extensions at the top which can flex.

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†I. T. S. Rubber Co. v. Essex Rubber Co., 272 U. S. 429, 443. While that case did not involve cancellation after interference, the principle has been specifically applied to adverse judgments in interferences, Greenwalt v. American Smelting & Refining Company, 3 F. (2) 658, 660, affirmed 10 F. (2) 98, 99. In the above case it was held in the District Court that

> "Whatever is excluded in interference cannot be included in the patent; and whatever cannot thus be included cannot be claimed by construction." 3 F. (2) 660.

The Master specifically found, R. 1105:

> "(48) That in Ex. 1 automatic compensation is accomplished by what has been termed the 'Keystone relief' and not by any web flexibility at the top; that **the circumferential slotting terminates at about the inside of the head flange** and that such a construction and arrangement does not secure the operation contemplated by the Gulick, Jardine and Maynard patents."

This finding was not only based upon the above evidence, but on tests which the Master had witnessed (R. 1092), in accordance with the Order of Reference, R. 44, as well as upon demonstrations to which he refers, R. 1122; furthermore, the above finding was based upon the testimony of Respondents' own witness, Jeffries, who, in stating the metes and bounds of the Jardine patent, testified, R. 230-1:

> "Q. Would you say that the objects and advantages and purposes of the Jardine patent are secured **if the slots 29 were shortened to terminate about the inside part of the ring flange 23?**
>
> A. It would be quite difficult to secure successful operation under those conditions."

Compare, see cuts below, Jardine's slot 29a into web 25 beyond inside of head flange 23. At the bottom, where web flexibility is not important (R. 1038), these webs in Exhibit 1 are braced by the arc of the skirt (as found by the Master, R. 1116) so that the piston skirt will be inflexible there. This is clear from the comparison of the cuts below:

Jardine

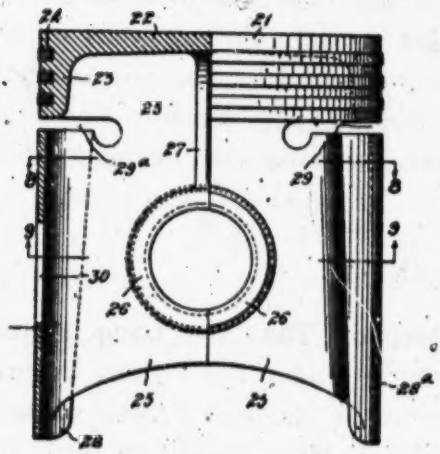

Exhibit 1

Surely Exhibit 1 does not have "the bending or flexing of **straight** ribs **so proportioned** as to yield—on the **cantilever** principle," for, apart from Jeffries' concession, R. 230-1, any web extension into the Keystone relief (upon which Respondent relied in the Court of Appeals) results in a web which is **curved** and **not straight**, and "of a springing resiliency in **arcuate** extensions of his (Hartog's) skirt sections," which the Court of Appeals distinguished from (2nd Dec., p. 8). The Master found non-infringement as a question of fact.*

The procedure, which the Court of Appeals followed, of first importing flexing webs into the claims, then still further importing "bending or flexing of straight ribs—on the cantilever principle," and then finding infringement by Exhibit 1, which is entirely outside of such a construction, has no basis in the law for the determination of either

*Infringement, at least in so far as it relates to correspondence of essential structure and mode of operation, is a question of fact. Bates v. Coe, 98 U. S., l. c. 49; U. S. v. Anciens, 224 U. S., l. c. 322; Stilz v. United States, 269 U. S., l. c. 147. So far as the finding of the Master or Judge, who saw the witnesses, depends upon testimony it must be treated as unassailable. Adamson v. Gilliland, 242 U. S., l. c. 353.

validity or infringement of patent claims. The claims, absent flexing webs, are invalid over the prior art. The claims present the particular straight flexing webs on the cantilever principle are not infringed by Exhibit 1, which has no such webs, as found by the Master, based on the admission of Respondents' witness and the tests which the Master witnessed.

POINT II.

The Court of Appeals' Decision That the Long Pistons Were Unavailing as a Defense Under the Patent Statute, R. S. 4886, Although Prior to the Earliest Proved Date of the Alleged Invention of the Jardine Patent in Suit, Unless the Scientific Explanation of the Mode of Operation of the Long Pistons Was Understood, Is Contrary to the Decision of This Court in De Forest Radio Co. v. General Electric Co., 283 U. S. 664.

As shown in the Statement, what are known as "Long" pistons were proved to have been sold and in commercial use in Franklin automobiles from 1917 on and the Master so found (R. 1102-3), as also stated by this court, 305 U. S. 53. The Court of Appeals did not question the existence and identity of the Long piston prior to Jardine, but rejected them as bars under R. S. 4886, because these pistons, although sold and in use prior to Jardine, were not known to have flexing webs or that such quality of flexibility of the webs was then understood (2d dec. p. 8). Such was the decision even though Respondents' own witness, Jeffries, when shown such a piston, proved as to time and structure, and with which he was familiar from 1920 on, R. 940, 987, admitted that it had flexing webs, 1009-10; indeed, this court noted that concession, 305 U. S. 55. Petitioners' witness, Stellmann, when an engineer with the Franklin Company, testified that he knew of the flexing quality of the Long pistons as early as 1916, R. 570.

The status of the Long commercial pistons is different than is the status of the Long patent as a bar under R. S. 4886. The Long patent operates as a bar as to what it discloses as a writing; the Long commercial pistons are operative as bars, as physical structures. The Long pistons, if proved as to date of existence of structure could be copied, and by Chinese copying at that, so it was immaterial whether the mode of operation of any of them was understood prior to Jardine's filing date.

R. S. 2886 provides that as a prerequisite to a valid patent, the subject matter of the patent shall have been:

> "not known or used by others in this country before his invention or discovery thereof—or more than two years prior to his application, and not in public use or on sale in this country for more than two years before his application."

R. S. 4920 provides for such prior knowledge, use or sale as a defense with notice in the answer. The answer here, R. 37-38, gave such notice as to prior knowledge, use and sale as to the Long pistons by Long and by Franklin Automobile Company.

The Patent Statutes do not say that the scientific explanation of a prior known or used or sold device must have been known to anybody.

In **De Forest Radio Co. v. General Electric Co.**, 283 U. S. 664, this court considered a radio tube which had been used by De Forest prior to the effective invention date of the patent in that suit. This court said (l. c. 686):

> "Whether De Forest knew the scientific explanation of it is unimportant, since he did know and use the device and employ the methods, which produced the

desired results, and which are the device and methods of the patent.'"*

In other words, this court did not require that the radio tube, the physical thing, known and used by De Forest, should have been "known to have that quality" or that this "was then understood," which the Court of Appeals required as a prerequisite to the Long commercial pistons constituting bars under R. S. 4886; and the radio tube was a much more critical thing than is a machined piston casting and was much more difficult of being reproduced.

A Proved Prior Use Is Inherently a Source of Knowledge.

There is a distinction between a prior art patent and a publication on the one hand and a prior use on the other hand.** Where a prior patent or publication is involved, the description must be complete enough to enable one skilled in the art to reproduce what is described; although here again it is immaterial that the prior patent or publication does not give the scientific explanation of the operation of the thing described.† **When, however, it comes to a prior use, then we have the article in existence, which can be duplicated.** Indeed the Chinese are noted for their "Chinese copying" of physical things, even though the oriental copyist may be wholly ignorant of the required

*This case was approved by this court in Smith v. Hall, 301 U. S. 216, 227, as applied to prior use of a process.

**The Court of Appeals recognized the "distinction between what may be disclosed in a patent and what may appear to the understanding of those skilled in the art when it reaches commercial embodiment so that it may be physically reproduced." R. 2403.

†"Even if the asserted difference were established, it is no more than the scientific explanation of what Lilienfeld and others knew, before Langmuir, of the effect of the high vacuum on the discharge, and the methods and devices for procuring the vacuum. It is method and device which may be patented and not the scientific explanation of their operation. See LeRoy v. Tatham, 14 How. 156, 174-6." De Forest Radio Co. v. General Electric Co., 283 U. S. 684-5.

properties and characteristics of the thing to be copied. That particularly applies to things which are capable of being produced by **casting** followed by machining or finishing. We see many instances of the copying of statues and other art objects by casting—even by using the original as a pattern for the exterior and by using the interior for making the core. It is, therefore, immaterial whether those skilled in the art knew what the characteristics were, because of such facility of duplication. If the contrary were true, then the discovery of the scientific explanation of many things, which had been in use, would permit patents to be secured for those old things. As an extreme case the discovery of the microstructure of an old cast metal article, would surely not entitle the discoverer to a new patent for the article as a "manufacture" under R. S. 4886.*

The facts in this case illustrate the basic truth of the above discussion. As shown in the Statement Long's piston, Exhibit F, was first cast in a sand mold, using the pattern, Exhibit GG-1, to make the mold, using the core box, Exhibit P, to make the core, and assembling the mold and core to form the mold cavity, into which was then poured the aluminum alloy to produce the casting. That was in 1919, but Gilbert, in 1932, took this same pattern and this same core box and made the casting, Exhibit NN, which is an exact reproduction of Exhibit F, except that the latter is machined.

But those skilled in the art (pattern maker, molder, machinist) were equally capable of reproducing Exhibit F at any time. Indeed Franklin Automobile Company did so

*Aluminum Company of America v. Sterling Products Corporation, 66 F. (2d) 958, C. C. A. 8, involved a claim for a chill cast aluminum alloy piston as an article of manufacture (l. c. 961). The Court of Appeals (l. c. 962) held the claim invalid in view of a prior knowledge and use of an English chill cast piston imported into this country, even though the claim described this piston in scientific language.

in 1919 and 1920 by producing the Franklin pistons, Exhibits E and G, which are substantial duplicates of Exhibit F, except that they were reproduced in iron molds. Weems and Chadwick were able to do the same thing.

A piston, particularly one that has been in use as Exhibit F, shows that it is much more reliable as a basis for copying than is a drawing or a description, even when contained in a patent. That is because such a physical thing **shows the exact thing**. Its composition, as an alloy, can be ascertained by chemical analysis and duplicated. Its hardness can be determined so that any heat treatment can be applied and the hardness duplicated. If it shows any weakness, additional metal can be added where weakness shows up. We have none of those details ascertainable from the Jardine patent specification. In short, the physical thing is the reliable thing, and that such was appreciated by Congress and the Patent Office is apparent from R. S. 4891, which provides:

> "In all cases which admit of representation by model, the applicant, if required by the commissioner, shall furnish a model of convenient size to exhibit advantageously the several parts of his invention or discovery."

The Long Pistons Proved as Prior to Jardine Admittedly Had Flexing Webs.

Here the Court of Appeals did not question the fact that before Jardine's earliest proved date, which is March 11, 1920, the filing date of his application, the Long pistons of the character represented by Exhibits E, F, G and R were in existence; for that was in accordance with the testimony of Petitioners, as well as Respondent's witnesses, as shown in the Statement. The basis of the rejection of these Long pistons as statutory bars to the Jardine patent was simply that the webs of these Long pistons were not "known to

have that (flexing) quality" or that this "was then understood" prior to Jardine's earliest proved date.

But the Long pistons, the physical things, were before the court and capable of reproduction by anyone skilled in the art and were so reproduced as shown by the successive reproduction of Exhibit F and the Exhibits E, G and R. The sole question is, therefore, do the Long pistons before the court have "flexing webs"? We have here the admission of Respondent's expert witness Jeffries that the Long piston, Exhibit F, has such flexing webs. As shown in the Statement, Jeffries was not only familiar with the Long pistons in 1920, the year Jardine filed, but that Aluminum Company of America made castings for those pistons for Franklin beginning with that year and continuing to 1926. Jeffries testified without qualification:

> "Q. What do you say, do you think the webs weren't flexible enough? You have the piston before you, so you ought to be able to tell something about it?
> A. No, there is flexibility in the webs" (R. 1009-1010).*

The question was not whether these webs were "flexible," but whether they were "flexible enough." The double negative, "weren't" and "no," makes the answer "yes," that they were flexible enough, which obviously meant flexible enough when the piston was used in the cylinder of an automobile engine, and the Court of Appeals obviously so understood it.

That admission of Jeffries should settle the matter that the Long piston, Exhibit F, whose existence, prior to Jardine's earliest proved date, was not questioned by the Court of Appeals, had flexing webs. It is immaterial whether it was known to anyone who used or sold these

*He was able to do that because Petitioners furnished a clamping device, Exhibit 3-I, which was used to test the various pistons.

Long pistons prior to Jardine's proved date, that these pistons had flexing webs. Even if Long and the engineers of Franklin Motor Company or others were ignorant of that fact** (as De Forest was of the reason why his radio tube worked), the Long pistons did work successfully from March, 1919, to 1926 in the Franklin automobile, and the fact that it may not have been known until the day of the trial, why they worked, is immaterial.

The Court of Appeals' Requirement of Knowledge or Understanding of Quality Is Contrary to This Court's Decisions.

The Court of Appeals, disregarding the decisions of this court in the De Forest-General Electric Case, seeks to establish a different rule by analogy, relying upon statements in Walker on Patents, Sixth Edition, based upon earlier decisions of this court, which do not apply here as shown by Walker in the very sections referred to by the Court of Appeals.

While Walker says, Section 106, p. 130:

> "Novelty is not negatived by any prior accidental occurrence or production, the character and function of which was not recognized until later than the date of the patented invention sought to be anticipated thereby."

Walker cites Tilghman v. Proctor, 102 U. S. 711, a process case involving manipulation and where the tangible thing did not remain in existence. But Walker in the same section makes the following distinction applying even to a process and so applied by this court in the De Forest-General Electric Case, which also involved process, as well as article claims:

**It was shown in the Statement that Stellman was not ignorant of that fact. R. 570.

> "But novelty is negatived by proof of prior use of a process, where that use was understood in point of method, though not correctly understood in point of result" (p. 131).

One of the cases cited by Walker is **Schultz Belting Co. v. Belting Co., 40 F. 156**, appeal dismissed, 154 U. S. 516. That case involved, as a new article of manufacture, "leather having tanned surfaces and an interior of pliable rawhide" (l. c. 157). The evidence showed that incompletely tanned leather had been in public use and on sale; that, of course, was the article of the patent, which was, therefore, held invalid.

Walker also says, Section 107, p. 131:

> "Novelty is not negatived by anything which was neither designed, nor apparently adapted, nor actually used, to perform the function of the thing covered by the patent."

Walker cites Topliff v. Topliff, 145 U. S. 156; but the statement in this Court's decision, l. c. 161, relied upon by Walker, had reference to a disclosure in a **prior** Stringfellow and Surles **patent** (see l. c. 160), and had no reference to a **physical thing**, which necessarily has the opposite of Walker's statement in that it

> was designed, adapted and actually used to perform the function of the thing covered by the patent,

namely, the design and adaptation of a piston to operate in a cylinder so as to automatically compensate for expansion, whether or not the designer understood why the result was obtained.

Furthermore, Walker continues, after making the above quoted statement, and says:

> "but this rule cannot govern any case which lacks either of the circumstances upon which it is founded,

for negation of novelty is not averted by the mere fact that the inventor of the prior device did not design it to perform the function of the patented device, nor by the mere fact that its ability to perform that function is not apparent to every beholder, nor by the mere fact that it was never actually used for that purpose, nor by any two of these facts combined'' (l. c. 131-132).

This court apparently appreciated the above by referring in its decision in this case, 305 U. S. 55, to ''the Long pistons, whose webs were concededly laterally flexible.'' Although the above statement had reference to the year 1922, in connection with Gulick copying the Hartog claims, Jeffries' concession was of a physical thing, Exhibit F, whose existence before Jardine's proved date was not questioned by the Court of Appeals. The Court of Appeals, however, said, in considering the statement of this court's opinion just quoted, that such observation of this court was not ''to be taken as a conclusion that the webs were flexible in use'' (2nd Dec., p. 7); however, we have previously shown, supra, that Jeffries' concession (R. 1009-10) was to that effect. Furthermore, the Court of Appeals had previously said, in considering this question of flexibility, ''probably no one has seen an automobile piston reciprocating in its cylinder'' (2nd Dec., p. 4). Respondent offered no test of any Jardine piston or of the accused piston (Exhibit 1) in an engine in order to determine their quality or whether the piston webs were flexible in use, but the tests of the Long, Franquist and Exhibit 1 were made with the clamping device, Exhibit 3-I, while no such test was made of the Jardine piston at all.

The Jardine Piston Is a Step Backwards in the Art.

We have shown in the Statement, p. 22, that the Long pistons were always relieved in the regions of the bosses

before Jardine filed, and that such a relief was a common expedient practiced as early as 1915, and that it was deemed unnecessary to show such relief in the Long patent.*

The Court of Appeals also showed that the Jardine slipper piston was produced from the Gulick piston when "he cut away all the skirt portions at the webs extending the latter to nearly the length of the skirt parts or slippers." But that had been done by Ricardo, while in Exhibit 1 these skirt parts are put back at the bottom as had been done by Schmiedeknecht in order to prevent oil pumping (R. 81-2). Indeed, the Court of Appeals' statement applies verbatim to the piston of the Long patent or the Long commercial pistons. The Jardine piston is in fact a step backward in the art as to Gulick and Long and never went into use.

The Evidence Establishes the Long Pistons Prior to Jardine.

While the Court of Appeals did not question the existence of the Long pistons before Jardine's earliest date, we have nevertheless discussed the evidence in the Statement. While we appreciate, as was said by this court in the Eibel Process Case, 261 U. S. 45, 60, "that evidence to prove prior discovery must be clear and satisfactory," the evidence here is certainly of such a character and is even more clear than the evidence which this court deems sufficient in Smith v. Hall, 301 U. S. 216.

While, of course, Exhibit F, to which we can limit our discussion, bears no date, it was identified by Petitioners', as well as Respondent's witnesses, as a piston which was

*In Honolulu Oil Corporation v. Halliburton, 306 U. S. 550, this court decided that the use of an old expedient "is necessarily implied from the language of the Franklin patent. Detailed description by Franklin was not necessary." l. c. 559.

used in the Franklin car in 1919, a year before Jardine filed, and even Respondent's witness Jeffries recognized it as having been made by Aluminum Company of America in 1920 for Franklin Automobile Company. Without any substantial change it was used in the Franklin automobile until 1926. Chadwick produced the pattern and core box used which produced it, and that this is true is self-evident from the fact that the casting, Exhibit NN, produced by the employment of the pattern and core box is a duplicate of Exhibit F, except that Exhibit F is machined. The Long patent, 1,872,772, with its filing date of March 7, 1919, is a duplicate of this piston, except that it does not mention the relief in the regions of the bosses, nor that the webs are flexible. Venner made an improvement prior to February 16, 1920, R. 1603, for which he filed an application on April 12, 1920 (R. 1595), and the castings for which were made by the Aluminum Company of America, R. 353, before February 16, 1920, R. 352,—and Venner was then familiar with the Long piston, R. 353. Aluminum Company of America, who made the castings for Venner's piston, as well as the Long pistons, both in 1920, did not dispute these facts, although it would have been so easy to do if the facts were not as stated by Petitioners and even Respondent's witnesses.

There is no doubt at all but that this array of evidence, the items of which check and interlock, establishes not only the existence of the Long piston, Exhibit F, at least a year before Jardine's earliest proved date of March 11, 1920, but that this Long piston, Exhibit F, had flexing webs at that time. The date of the pattern and of the core box and their use in producing Exhibit F have been established as before that date; the casting, Exhibit NN, produced by it is a duplicate of that Exhibit F and has the same webs, and Exhibit F admittedly has flexing webs.

The Long Pistons Were Commercially Successful Prior to Jardine.

That this Long piston was not only operative, but highly successful commercially, is not only evidenced by the fact that from 1917 to 1923 it was the only piston which had a split skirt and automatically compensated for expansion, but its use in the Franklin engine from 1919 to 1926 to the extent of over 350,000 pistons established even extensive commercial successful use of this piston beyond a doubt. The fact that in 1926 it was replaced by a steel strut piston does not detract from it, particularly when we consider the circumstances that Long was literally driven out of the field by Respondent. Apart from that, however, it was to be expected that something else would come along, and this court did not deem that to effect a situation of this kind, Eibel Process case, 261 U. S. 45, 69. However, as noted previously, Exhibit 1 never did replace the Long piston in the Franklin automobile air-cooled engine. Moreover, it is immaterial that the prior use "was neither the best nor as skillfully designed or used as that later employed" by even the patentee of the patent in suit. Smith v. Hall, 301 U. S. 216, 232.

The Jardine Claims Are Invalid Over the Prior Art.

If the claims are taken as they read, which they should be as shown under Point I above, then they are completely anticipated by the Long commercial pistons whether or not these had flexing webs. They are likewise anticipated by the Long commercial pistons, even if flexing webs are read into the Jardine claims, because the Long pistons in use prior to Jardine's earliest proved date actually had flexing webs. It is immaterial whether the scientific explanation of the operation of the Long piston was known before Jardine's date when, as shown by the evidence, these pistons actually had such flexing webs. The Court

of Appeals erred in considering these Long commercial pistons unavailing as a defense under R. S. 4886, whether or not these Long pistons had flexing webs, and further erred in requiring that as a prerequisite to a bar under R. S. 4886 the Long pistons must have been "known to have that (flexing) quality" or that this "was then understood" prior to Jardine's earliest proved date.

The claims of the Jardine patent are also invalid over the prior patents and publications discussed in the Statement, whether or not these claims be construed as having flexing webs. Jardine was not the inventor of a piston having flexing webs, for as this court said, 305 U. S. 59:

> "Webs having the inherent properties both of rigidity and flexibility were familiar elements in piston structure."

The Hartog patent (R. 1798) disclosed flexing webs in a full skirt piston, and Exhibit 1, which the Court of Appeals decided infringed the Jardine patent, is essentially a full skirt piston, like that of Schmiedeknecht, which has the same relief in the regions of the bosses as has Exhibit 1.* The Pomeroy patent (R. 1804) discloses even a slipper piston with flexing webs.

With such flexing webs known as familiar elements, as found by this court, those skilled in the art would naturally have proceeded to make the webs of the Gulick and Long patents flexible, if such web flexibility were desired; and the Court of Appeals in its first decision (p. 10) found that the Jardine piston was readily producible from the Gulick piston by cutting away the skirt parts in the regions of the bosses, when a Ricardo type slipper piston was desired.

The Ricardo piston is the prototype of the Jardine pis-

*In Smith v. Hall, 301 U. S. 216, 232, this court held claims invalid where a patent claim was "stretched" to make out a case of infringement and when so expanded was found in the prior art.

ton, and to split one or both slippers was obvious where the known result of such splitting was desired; for as this court said, 305 U. S. 53: "flexibility of the skirt attained by longitudinal slits was old," and Respondent's witness Jeffries admitted, R. 227, that the webs of this Ricardo piston would flex if "vertical slots were put in the thrust faces."

POINT III.

The Court Below Erroneously Ordered the Issuance of an Injunction Restraining Petitioners From the Sale of Pistons Like Exhibit 1, Which Is All Aluminum.

The second decision of the Court of Appeals (p. 10) and the Mandate (R. 2395) order

> "an injunction restraining manufacture, use, and sale of Exhibit 1 and all substantial equivalents thereof."

Respondent has no such interest in the Jardine patent as to entitle it to an injunction. It is elemental that an injunction should not issue unless the party claiming it can show a definitely threatened invasion of one of his rights. The right which is invaded or violated must be a right of the Plaintiff, and not a right of some one else.

If Respondents should do what Petitioners did (sell aluminum pistons like Exhibit 1) Respondent itself (under the decision of the Court of Appeals) would be infringing the Jardine patent, because in the very same instrument whereby Respondent acquired title to the Jardine patent (Exhibit 38b, paragraph XXII, R. 1391) Respondent transferred to the Aluminum Company of America the exclusive right to make, use and sell aluminum pistons (Exhibit 38b, R. 1382).

As far as aluminum pistons are concerned, therefore, neither Respondent, nor the Trust Estate which it represents, ever has had the right under the Jardine patent to

make, use or sell, or to exclude others from so doing. Having no such right, it is not entitled to an injunction.

The question here is not whether the Aluminum Company of America is an exclusive* or nonexclusive licensee, as the Court of Appeals seems to have thought. Admittedly there are two licensees (other than the Aluminum Company of America) under all the eighty-odd patents held by the Trust Estate. The controlling fact here is that neither Respondent, nor the Trust Estate which it represents, ever has had those incidents of ownership in the Jardine patent which are necessary to entitle it to an injunction when suing alone. Regardless of how many licensees there may be, only Respondent, The Cleveland Trust Company, is in court as plaintiff, and that plaintiff has not the right to make, nor the right to sell, nor the right to use, aluminum pistons, nor does it have the right to license others so to do, and consequently Respondent can have no right to an injunction.

While this question of patent law is novel in so far as this Court is concerned, it has been considered by the lower Federal Courts in Kaiser v. General Phonograph Supply Company, 171 Fed. 432, and Doherty Research Company v. Vickers Petroleum Company, 80 Fed. (2d) 809. In both cases it was held that a mere title holder,** such as Respondent here, was not possessed of those rights which are essential to entitle a party to maintain a suit in equity for an injunction restraining infringement of letters patent. While such a mere title holder may have a claim for money damages against an infringer, that claim may only be prosecuted in an action at law.

Since Respondent has no right to an injunction, the Bills

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*One may be an exclusive licensee, though not a sole licensee. Paul E. Hawkinson Co. v. Carnell, 112 F. (2) 396, 398, C. C. A. 3.

**In the Doherty v. Vickers Case, the plaintiff was more than a title holder, as he had a license to use.

should be dismissed, for, as this Court held in Peters Patent Corp. v. Bates & Klinke, 295 U. S. 392, l. c. 394:

> "The right to such an injunction underlies the equitable jurisdiction here invoked."

To entertain these suits in equity when respondent has no right to injunction violates Section 384 of Title 38, United States Code.

CONCLUSION.

As shown under Point I, the Court of Appeals actually found that absent flexing webs, the prior art was a complete answer to the claims of the Jardine patent, and only sustained them by reading into each of these claims such flexing webs. Since that was contrary to the decisions of this court, these claims are clearly invalid.

As shown under Point II, the Court of Appeals refused to hold the Long commercial pistons statutory bars under R. S. 4888, because the webs of the Long pistons were "not known to have that (flexing) quality," or that this "was then understood." This was contrary to the decisions of this court; accordingly the claims of the Jardine patent are invalid over these Long commercial pistons.

While we appreciate the fact that this cause is before this court on the questions upon which the Petitions for Writ of Certiorari were based, Petitioners' Assignment of Error 4, is directed to the invalidity of the Jardine patent in suit. In Altoona Theatres v. Tri-Ergon, 294 U. S. 477, 493, this court held two claims of the patent "invalid because of improper disclaimers." In Smith v. Hall, 301 U. S. 216, 232, this court held the patent invalid, where a broad construction of the claims had been obtained in the previous case decided by this court, and where in the second case a prior use was within such broad construc-

tion; and the patentee was not permitted to "narrow it so as to avoid anticipation by showing that the claimed method was used in a particular form of structure not claimed." In Mast Foos & Co. v. Stover Mfg. Co., 177 U. S. 485, this court, on a Petition for Writ of Certiorari, at a preliminary injunction stage, ordered the dismissal of the Bill, because of invalidity of the patent, 1. c. 495. This court can do so in this case.

As to the question of infringement, Petitioners' Assignment of Error 4, is directed to non-infringement of the Jardine patent. If the Jardine patent is construed to cover a piston with "flexing webs," or still more specifically a piston with "the bending or flexing of straight ribs so proportioned as to yield to the thermal expansion of the bosses on the cantilever principle," as the Court of Appeals finally limited the claims, by construction, then Exhibit 1 is entirely outside of such claims in view of Jeffries concession on which was based the Master's finding of non-infringement.

As to point III, determination of that question may not be necessary, if either or both questions I and II are ruled upon in favor of Petitioners. This point III does, however, present an important question of practice in patent cases, particularly in cases involving patent pools. This court passed upon a question in Hurn v. Oursler, 289 U. S. 238, 240, in order to settle a question of practice that the rule of the Circuit Court of Appeals "may not be followed as a precedent," even though the decision on that point was not necessary for the determination of the case upon its merits. Respondent still has over seventy piston patents on which it may seek to obtain decrees for injunctions.

For the reason stated, we urge that the Jardine patent here in suit is invalid, that Petitioners have not infringed,

that Respondent is not entitled to an injunction, and that the decision of the Circuit Court of Appeals for the Sixth Circuit should be reversed.

Respectfully submitted,

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August 31, 1940.